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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/517,596	09/29/2005	Kam Man Hui	P08512US00/BAS	9105

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EXAMINER

HOFFMAN, SUSAN COE

ART UNIT	PAPER NUMBER
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1655

MAIL DATE	DELIVERY MODE
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05/30/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/517,596	Applicant(s) HUI, KAM MAN	
	Examiner Susan Coe Hoffman	Art Unit 1655	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 March 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 8, 10 and 11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 8, 10 and 11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The amendment filed March 13, 2007 has been received and entered. The text of those sections of Title 35, U.S. Code, not included in this action can be found in a prior Office action.
2. Claims 4-7, 9 and 12-14 have been cancelled.
3. Claims 1-3, 8, 10 and 11 are pending.

Claim Rejections - 35 USC § 102

4. Claims 1, 2, 8, 10 and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by US Pat. Pub. No. 2001/0018076 for the reasons set forth in the previous Office action.

All of applicant's arguments regarding this ground of rejection have been fully considered but are not persuasive. Applicant argues that this reference does not anticipate the claimed method because the reference does not specifically teach using the claimed extract to treat breast cancer, liver cancer, or melanoma. However, applicant's claims also recite that the *Fagopyrum dibotrys* composition is used to treat an individual at risk for developing these cancers. Every individual is at risk to develop liver cancer or melanoma because every individual has these organs. In addition, every female is at risk of developing breast cancer. The reference specifically teaches treating cervical cancer; thus, the reference specifically teaches administering the composition to women. Thus, applicant's method is considered to encompass administering the *F. dibotrys* to any individual because every individual is at risk for developing the claimed cancers. Therefore, since the reference is administering the same composition as claimed to the same patient as claimed, the reference is considered to inherently anticipate the claimed method.

Claim Rejections - 35 USC § 103

5. Claims 1 and 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Pat. Pub. No. 2001/0018076 for the reasons set forth in the previous Office action.

Applicant argues this rejection in combination with the arguments regarding the 102 rejection based on this reference. Therefore, this rejection is still considered valid for the reasons discussed above and in the previous Office action.

6. Claims 1 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Pat. Pub. No. 2001/0018076 in view of Liu et al. (Zhongguo Yaolixue Tongbao (1998), vol. 14, no. 1, pp. 36-9).

US '076 teaches a pharmaceutical composition extracted from *Fagopyrum cymosum*. According to applicant's specification, *F. cymosum* is a synonym for *F. dibotrys* (see page 1). The extract is made by extracting crushed *F. cymosum* rhizome with methanol or ethanol, with ethanol being preferred. The solvent is evaporated from the liquid extract under reduced pressure to create a concentrated extract. The extract is then fractionated by macroporous resin (see paragraphs 34, 38, and Example 1 on pages 7 and 8). The extract is made into a pharmaceutical composition which is used to treat cancer. While the reference specifically teaches that the composition has anti-cancer properties, the reference does not specifically teach using the composition to treat melanoma.

Liu teaches that extracts from *F. cymosum* inhibit melanoma cells (see English abstract). Thus, it was known in the art at the time of the invention that anti-cancer extracts from *F. cymosum* are useful against melanoma. Therefore, an artisan of ordinary skill would reasonably expect that the anti-cancer extract of US '076 would also be useful in treating melanoma. This

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reasonable expectation of success would motivate the artisan of ordinary skill to use the *F. cymosum* extracts of US '076 to treat melanoma.

7. No claims are allowed. However, claims directed solely to the claimed method of *treating* breast and liver cancers using the claimed extract would be considered allowable.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan Coe Hoffman whose telephone number is (571) 272-0963. The examiner can normally be reached on Monday-Thursday, 9:30-5:30.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terry McKelvey can be reached on (571) 272-0775. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Susan C. Hoffman
Primary Examiner
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